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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/089,871	06/04/1998	RUDOLF CAROLUS MARIA BARENDSE	97253-A	3289

25225 7590 08/15/2006

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
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SAN DIEGO, CA 92130-2040

EXAMINER

RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/089,871	BARENDSE ET AL.	
	Examiner	Art Unit	
	Delia M. Ramirez	1652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: attachment-cornstarch information.

ADVISORY ACTION

1. Claims 18-19, 21-28, 31-35, 42-52 are pending.
2. The request for reconsideration, submission of nutritional information regarding soy flour, and arguments filed on 7/13/2006 under 37 CFR 1.116 in reply to the Final Action mailed on 5/18/2006 are acknowledged. However, the arguments and evidence presented is not deemed persuasive to withdraw the previous rejections for the following reasons.
3. Applicant traverses the rejection of claims 18-19, 21-28, 31-35, and 41-52 under 35 USC 112, first paragraph, new matter, and asserts that all the examples in which a granulate is formed, i.e., Examples 5-9, contain no fibrous materials. According to Applicant, the specification teaches that elimination of fibrous materials from the extruded granulate will enable such granulates to be made by extrusion. Thus, it is Applicant's contention that granulates lacking fibrous materials are within the scope of the invention as conceived by Applicant at the time the application was filed. Applicant also argues that even if Applicant included fibrous materials as part of the granulates, such components can be excluded in accordance with MPEP 2173.05(i).
4. Applicant's arguments have been fully considered but are not persuasive to withdraw the new matter rejection previously applied. The Examiner disagrees with Applicant's contention that the granules of Examples 5-9 provided in the specification lack fibrous materials. Examples 5, 8 and 9 use cornstarch, which contains dietary fiber as shown in the USDA's cornstarch nutrition content information provided with this action. While one could argue that the specification discloses granules where a limited amount of fibrous material is allowed, the specification does not disclose a granulate which lacks fibrous materials as a preferred embodiment of the claimed invention. With regard to references to MPEP 2173.05(i), it is noted that the Examiner is not contending that negative limitations are not permitted in the claims. Instead, as indicated in MPEP 2173.05(i), any negative limitation or exclusionary proviso must have basis in the original disclosure. For the reasons extensively discussed in the Final action

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mailed on 5/18/2006 and those set forth above, there is no basis in the original disclosure for a granulate lacking fibrous materials, and compositions thereof.

5. Applicant traverses the rejections under 35 USC 103(a) of (1) claims 18-19, 21, 24-28, 31-35, 41-45, 48-52 over Nielsen et al. in view of Ghani, (2) claims 22-23, 46-47 over Nielsen et al. in view of Ghani and further in view of Markussen et al., (3) claims 18-19, 21-22, 24-28, 31-35, 41-46, 48-52 over Nielsen et al. in view of Ghani and further in view of Haarasilta, and (4) claims 23 and 47 over Nielsen et al. in view of Ghani and Haarasilta, and further in view of Markussen et al. on the grounds that (a) Ghani discloses using soy flour which contains 4 grams of fiber per $\frac{1}{4}$ cup as shown in Exhibit A, (b) none of the references teach that it is desirable to make granules without fibrous materials to avoid mechanical malfunction or to produce smaller granules, (c) none of the references suggest that granulates should exclude fibrous materials, and (d) there is no motivation to remove fibrous materials from Nielsen's granulate. Applicant also submits that while the Examiner has indicated in the Final action, page 7, that Applicant must provide evidence that shows that no granulate can be formed by extrusion without fibrous materials, it is the Office that must show references which teach or suggest forming granulates by extrusion without fibrous materials.

6. Applicant's arguments have been fully considered but are not persuasive to withdraw the obviousness rejections previously applied. The Examiner acknowledges Exhibit A and agrees that none of the references cited teach that it is desirable to make granules without fibrous materials to avoid mechanical malfunction or to produce smaller granules. However, as indicated in the Final action mailed on 5/18/2006, Ghani teaches granulates where neither the carrier nor the binder have fibrous materials such as regular or spray-dried lactose and corn syrup (column 2, lines 26-52). While it is agreed that neither Nielsen nor Haarasilta specifically teach making granulates lacking fibrous materials, neither the references nor the prior art teach away from making granulates which lack fibrous materials. The Examiner never indicated that the motivation for making granulates lacking fibrous materials could be

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found in the cited references. Instead, the Examiner found motivation to make granulates lacking fibrous material in the knowledge generally available to one of ordinary skill in the art. With regard to Nielsen's granulate, it is noted that the phytase granulate of Nielsen while disclosed to be used to increase the solubility of proteins present in vegetable sources, has also been disclosed as a separate animal feed additive which can be mixed with feed components, wherein said feed compositions comprise high amounts of vegetables. See, for example, page 10, lines 16-18, where it is stated that "in a specific embodiment the animal feed additive of the invention is a granulated enzyme product which may readily be mixed with feed components", and page 10, lines 28-31, where it is stated that "The feed additive of the invention is particularly suited for addition to animal feed compositions containing high amounts of proteinaceous vegetables, in particular legumes, cereals, composite plants or crucifera.". Thus, contrary to Applicant's assertions, (1) the granulate of Nielsen has not been disclosed as requiring fibrous materials to be satisfactory for its intended purpose, and (2) the granulate of Nielsen lacking fibrous materials would not render a composition unsatisfactory for its intended purposes because the granulate of Nielsen has been disclosed as a separate additive which can be added to the feed that contains the fibrous vegetables. Nielsen does not teach that the granulate requires the fibrous materials to allow manufacture of the granulate or to allow the phytase to act on its substrate. The granulate of Nielsen et al. does not have to include fibrous vegetables and neither Nielsen nor the other references cited teach away from a granulate lacking fibrous materials.

The Examiner has never indicated that Applicant must provide evidence that shows that no granulate can be formed by extrusion without fibrous materials. Instead, the Examiner indicated the fact that neither the art nor Applicant has provided any evidence that there is no reasonable expectation of success at making a granulate lacking fibrous materials (e.g., unexpected results). This is relevant to the issue at hand because if such evidence/teaching were to be available, the Examiner would have to include that information in the obviousness analysis. Since such evidence/teaching is not present and there is no

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reason to believe that a granulate lacking fibrous materials cannot be made by extrusion, one of skill in the art would conclude that there is a reasonable expectation of success at making such granulate.

7. The rejections previously applied are, therefore, maintained for the reasons and those set forth above.

8. For purposes of Appeal, the status of the claims is as follows:

Claim(s) allowed: NONE

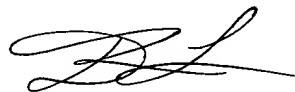
Claims(s) objected to: NONE

Claim(s) rejected: 18-19, 21-28, 31-35, 42-52

Claim(s) withdrawn from consideration: NONE

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
August 11, 2006